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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appl. No.	: 10/661,361	Confirmation No. 6762
Applicant	: David A. Mackiewicz, et al.	
Filed	: September 12, 2003	
Art Unit	: 3731	
Examiner	: Elizabeth Houston	
Title	: RADIOPAQUE MARKERS FOR MEDICAL DEVICES	
Docket No.:	: ENDOS 64949 (G4164US01)	
Customer No.	: 68,919	August 24, 2010

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

**REPLY BRIEF**

Dear Sir:

This Reply Brief is filed in response to the Examiner's Answer dated June 24, 2010. This Reply Brief is being filed within two (2) months of the date of the Examiner's Answer. In the event that fees are required, authorization is hereby provided to charge our Deposit Account No. 06-2425 any fees due in connection with this paper.

## **I. STATUS OF CLAIMS**

### **A. Total Number of Claims in the Application**

The claims in the application are: Claims 1-4, 6-15, 17, 18, 21, 32, 42-52. Claims 5, 16, 19, 20, 22-31 and 33-41 have been canceled without prejudice.

### **B. Status of All Claims on Appeal**

Claims 1-4, 6, 7, 32, 42, 51 and 52 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,741,327 to Frantzen (the "Frantzen patent") in view of DE Patent 19728337 to Ehrfeld (the "Ehrfeld patent").

Claims 8-15, 17, 18, 21 and 43-50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Frantzen patent in view of the Ehrfeld patent and in further view of U.S. Patent No. 6,503,271 to Duerig et al. (the "Duerig patent").

### **C. Claims on Appeals**

The claims on appeal are each of pending claims 1-4, 6-15, 17, 18, 21, 32, 42-52. A copy of the claims being appealed was previously appended as Exhibit 1.

## **II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

### **GROUND I**

Whether claims 1-4, 6, 7, 32, 42, 51 and 52 were improperly rejected under 35 U.S.C. § 103(a) as being unpatentable over the Frantzen patent in view of the Ehrfeld patent.

### **GROUND II**

Whether claims 8-15, 17, 18, 21 and 43-50 were improperly rejected under 35 U.S.C. § 103(a) as being unpatentable over the Frantzen patent in view of the Ehrfeld patent and in further view of the Duerig patent.

### **III. ARGUMENTS**

#### **GROUND I**

##### **A. Rejection of the Claims Based on the Frantzen and Ehrfeld Patents**

Claims 1-4, 6, 7, 32, 42, 51 and 52 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Frantzen patent in view of the Ehrfeld patent. The Examiner has taken a position regarding the structure disclosed in the Ehrfeld patent which is totally unreasonable and frankly incorrect. Each and every rejected claim requires a radiopaque marker having substantially linearly extending contact edges which contact substantially linearly extending contact edges formed on the longitudinally projecting fingers that form the marker holder. The Examiner takes the position that the Ehrfeld patent discloses a substantially linearly extending contact edge on the fingers (26, 27) and prong and relies primarily on the structures shown in FIGS. 4a and 4b of the Ehrfeld patent to support this position. Appellant respectfully submits to the Board that the Examiner's position is unreasonable in that the Ehrfeld device clearly has zigzag contact edges which cannot be reasonable construed as being linearly extending contact edges.

The Examiner relies on a dictionary definition of the word "linearly" which actually supports Appellant's position. The dictionary definition relied upon by the Examiner states that "linearly" is defined as "having the form of or resembling a line." Appellant believes that no one skilled in the art would interpret the zigzag contact edge disclosed in the Ehrfeld patent as being linearly extending as it in no way takes the form of a line or in no way resembles a line. The Examiner states that a linearly extending line could be interpreted as a line that just "happens to have several bends." The Examiner's position would be correct if the claims called for a curved line or a non-linear line. However, such a position does not support the finding of a linearly extending line. The Examiner's position is not only

unreasonable but defies the clear meaning of term as it is known in the English language. Again, Appellant respectfully submits that no one skilled in the art would take such a position.

The Examiner further takes the position that the claim language "fingers which define a substantially V-shaped opening" can be interpreted such that the V-shape opening needs only be formed on a portion of only one of the fingers. Again, the Examiner has taken a position in which the claim language is interpreted overly broad. The Examiner states that nothing in the claim terminology requires the opening to be formed by the combination of both fingers. However, it must be pointed out that the claim language states that a **pair** of projecting fingers define the substantially V-shaped opening. The claim language calls for the pair of fingers to be arranged relative to each other to cooperatively form the substantially V-shaped opening. The Examiner's position that the claim could be interpreted such that a V-shaped opening could be formed on an individual finger defies the clear reading of the claim. Appellant again believes that one skilled in the art would not interpret the claim language as the Examiner has done.

Appellant further submits that the Examiner's position regarding the manner in which the device disclosed in the Frantzen patent would have to be modified by the device disclosed in the Ehrfeld patent requires one skilled to **completely ignore the clear teachings** of both of these references. The Ehrfeld patent teaches **a mechanism for locking the struts forming the stent body** to maintain the stent in an expanded configuration. As such, one skilled in the art would readily recognize this feature and would incorporate it into the stent body of the Frantzen stent, not the radiopaque marker and marker holder, as is suggested by the Examiner. The Examiner's suggested modification compels one skilled in the art to totally disregard the features of this stent locking mechanism of Ehrfeld and

requires those skilled in the art to completely replace the marker holder and marker disclosed in Frantzen. However, even assuming *arguendo* that one skilled in the art would combine the references in the manner suggested by the Examiner, the resulting structure would still lack the substantially linearly extending contact edges recited in the claims along with the V-shaped opening created by the pair of projecting fingers. Accordingly, Appellant submits that the Examiner has taken a position which is unrealistic and far cry from the manner in which one skilled in the art, in viewing both the Frantzen and Ehrfeld patents, would attempt to combine the features disclosed in each patent.

For all of these reasons, it is clear that the Examiner has failed to establish a *prima facie* case of obviousness based on the combination of the Frantzen patent and the Ehrfeld patent.

## **GROUND II**

### **A. Rejection of the Claims Based on the Frantzen, Ehrfeld and Duerig Patents**

Claims 8-15, 17, 18, 21 and 43-50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Frantzen patent in view of the Ehrfeld patent and in further view of the Duerig patent. All of these claims have been rejected on the basic combination of the Frantzen patent and the Ehrfeld patent. As addressed above, the combination of the Frantzen patent with the Ehrfeld patent simply fails to create the basic structure recited in the rejected claims. The Duerig patent has been cited merely to show the use of a particular alloy for manufacturing the marker. This secondary reference relied on the Examiner fails to address the shortcomings of the Frantzen/Ehrfeld combination in achieving the basic structure of the rejected claims. For this reason alone, the combination of references

suggested by the Examiner would simply not produce the structure recited in the rejected claims.

#### **IV. CONCLUSION**

Appellant respectfully requests the Examiner to reconsider the rejections of the claims and to withdraw the Examiner's Answer before this case is decided on the merits by the Board of Appeals. The Examiner's combination of these two references fails to create the basic structure recited in all of the pending claims. In the event that the case is to be decided on the merits, Appellant respectfully requests the Board to reverse the rejection of all of the rejected claims and allow these claims to pass to issue.

Respectfully submitted,

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